

Attorney Docket No. 00-VE20.56 (65632-0133)

Serial No. 09/258,123

REMARKS**Introduction**

Claims 1-12, 25-53, and 68-84 are pending. Claims 1, 25, 40, and 68 are independent claims. The Office Action rejected claims 1-12, 25-39, and 68-84 under 35 U.S.C. § 112, first paragraph. (Office Action, paragraph 5.) Further, the Office Action rejected claims 1-12 and 40-53 under 35 U.S.C. § 112, second paragraph.¹ (Office Action, paragraph 7.) The Office Action did not make any rejection of Applicants' claims based on the prior art of record.

Claims 25 and 68 have been amended to clarify the subject matter recited therein; the amendments are not believed to alter the scope of the claims. Claims 43 and 71 have been amended to put these claims in form for allowance by deleting the word "additional", which Applicants had intended to delete in earlier responses. Applicants request reconsideration of all pending claims in view of the amendments and remarks herein.

Applicants thank the Examiner for the courtesies extended during the telephone interview with Applicants' representatives on February 12, 2004. Applicants had requested this interview after receiving the Advisory Action. In the Advisory Action the Examiner declined to enter the amendments proposed in Applicants' Office Action Response Pursuant to 37 C.F.R. § 116, filed December 23, 2003 ("First Rule 116 Response"). During the interview, the Examiner pointed out a formal difficulty with claims 43 and 71 that the present amendment is intended to rectify. Further, the Examiner indicated that the proposed amendment to independent claims 25 and 68 overcomes the rejection of those claims under 35 U.S.C. § 112 and therefore likely renders those claims allowable. Further, the Examiner indicated that claim 1 would be allowable if Applicants explained further how the specification discloses "parsing the page heading to produce an index." The Examiner further indicated that resolving the Office Action's rejections under 35 U.S.C. § 112, first paragraph would likely resolve the Office Action's rejections made under 35 U.S.C. § 112, second paragraph.

¹ Applicants note that claims 20 and 57-60 have been cancelled, and therefore Applicants presume that the Examiner did not intend to include a rejection of claims 20 and 57-60 in the Office Action, even though paragraph 7 of the Office Action refers to them. Further, claims 71-74 depend from independent claim 68, which the Office Action did not reject under the second paragraph of Section

Attorney Docket No. 00-VE20.56 (65632-0133)

Serial No. 09/258,123

Rejection of Claims 1-12, 25-39, and 68-74 under 35 USC § 112, First Paragraph

During the February 12, 2004 telephone interview (the "interview"), Applicants' representatives and the Examiner discussed the specification's disclosure of "parsing the page heading to produce an index" as recited in claim 1. In particular, the Examiner questioned the fact that the specification does not use the words "produce" or "producing" with reference to the index. Accordingly, Applicants herein explain that the specification does disclose *producing* an index. The specification says:

Once the image files are formed, they allow viewing of an image of every page in the directory as it is to be printed. However, to be useful, the files should preferably be indexed somehow. In particular, for an online directory, it is desirable to provide a page and category (header) index so that a user can access a particular page by its page number or by a category found on that page. Since it is common for categories to span multiple pages, it is contemplated that each category will be indexed to the first page on which the category occurs. For an electronic billing system, it is desirable to identify the page on which a particular advertisement appears and the page that will be printed on the opposite side of the same sheet in the printed directory; it is also desirable to highlight the position of the advertisement on the page.

One way to compile the information just described is to provide an interface, called a directory print composition interface, with the system that composed the original EPS representations of the pages. Such a system typically runs an Oracle DBMS, provided by the Oracle Corporation of Redwood, California, that indexes each advertisement by the spine number of the directory in which the advertisement appears, the advertisement number which identifies the advertisement within the directory, the heading (category) under which the advertisement appears and the page on which the advertisement appears when the directory is composed. Such information can be used to match each category with the first page on which it appears, which allows a user to type in a name of a category and be taken to the appropriate page. That information, combined with the rectangle definition file, can be used in the electronic billing system to highlight the specific advertisement. The directory print composition interface should be customizable to accommodate EPS files and page/advertisement/category indexing data from any directory publisher. Also, any other source of the needed information can be used, such as a text file of page/heading information or of advertisement rectangle information. (Specification, page 10, line 12 – page 11, line 11.)

The specification clearly discloses "producing" an index inasmuch as it teaches forming image files and then providing an index to enable users to access particular pages, *i.e.*, after image files are formed an index to them is produced. (Specification, page 10, lines 12-16.) The specification then goes on to discuss how the index is produced. As Applicants' representatives and the Examiner discussed during the interview, with reference to the above passage from the specification it should be clear that a system running an Oracle DBMS may be used to compile the index. Specifically, the specification discloses producing the index using the system that

112, and Applicants therefore assume that the Examiner did not intend to include a rejection of claims 71-74 in the Office Action, even though paragraph 7 of the Office Action refers to them.

Attorney Docket No. 00-VE20.56 (65632-0133)

Serial No. 09/258,123

composed the original EPS representations of the pages. (Specification, page 10, lines 22-25.) Accordingly, claim 1 recites "parsing the page heading data to produce an index."

Further, to the extent there is any question about "parsing the page heading data", as the Examiner pointed out during the February 12, 2004 interview, Figure 4 describes parsing data; Applicants note that in fact Figure 4 and portions of the specification describing Figure 4 (see page 17, line 18 – page 18, line 6) disclose parsing data, including directory information such as page headings, for display in a graphical user interface.

Accordingly, claim 1 is in condition for allowance with respect to Section 112, first paragraph. Claims 2-12 were rejected solely by reason of their dependency on claim 1, and therefore also are in condition for allowance with respect to Section 112, first paragraph.

Based on the interview, claims 25-39 and 68-84 are not otherwise addressed herein, but Applicants' comments in the First Rule 116 Response are fully incorporated herein by reference.

Rejection of Claims 1-12 and 40-53 under 35 USC § 112, Second Paragraph

Claims 1-12 and 40-53 are rejected under 35 U.S.C. § 112, second paragraph. Inasmuch as the Examiner indicated during the interview that these rejections likely would fall if the above rejections under 35 U.S.C. § 112 were adequately addressed, these rejections are not further addressed herein, but Applicants' comments in the First Rule 116 Response are fully incorporated herein by reference.

Attorney Docket No. 00-VE20.56 (65632-0133)

Serial No. 09/258,123

CONCLUSION

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance, and a Notice to that effect is earnestly solicited.

Any fees associated with the filing of this paper should be identified in an accompanying transmittal. However, if any additional fees are required in connection with the filing of this paper, permission is given to charge Deposit Account No. 07-2347.

Respectfully submitted,

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